

REMARKS/ARGUMENT

Claim 9 is amended. The amendments to this claim are for clarification purposes only and not intended to limit the scope of this claim in any way.

Claims 1, 2, 3, 4, 6 and 8 are rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent 6,333,459 to Sato et al. ("Sato"). Claims 5, 9 and 10 are rejected under 35 U.S.C. §103 as being obvious in view of Sato. Reconsideration of the application in light of the remarks below is respectfully requested.

Rejections Based Upon 35 U.S.C. §102

Among the limitations of independent claim 1, which are neither shown nor suggested in Sato are: "an elastic member supporting said electronic part within said device body."

Similarly, among the limitations of independent claim 2, which are neither shown nor suggested in Sato are: "an elastic member supporting said printed board within said device body."

The Office Action points to element 57 in Fig. 4 as corresponding to the elastic member as claimed. The Sato disclosure indicates that aside from element 57, the structure in Fig. 4 is virtually identical to that shown in Figs. 1-3. Column 8, lines 9-11. In Figs. 1-3, circuit board 10 is mounted to side walls 38 of second shield case 16. Column 5, lines 3-7; column 6, lines 42-50; Fig. 3. Second shield case 16 is, in turn, supported by support ribs 51 on bottom casing 25. Thus, springs 57 do not support circuit board 10 as is claimed.

Therefore, it is asserted that independent claim 1 is patentable over Sato. Claims 2-4, 6 and 8 include the above referenced limitations of claim 1 and include further limitations which, in combination with the limitations of claim 1, are also neither disclosed

nor suggested in Sato. It is asserted that these claims are patentable as well.

Reconsideration of the rejection of claims 1-4, 6 and 8 under 35 U.S.C. §102 is respectfully requested in light of the remarks above.

Rejections Based Upon 35 U.S.C. §103

With respect to claim 5, this claim is dependent upon independent claim 1. As stated above, claim 1 includes limitations which are neither shown nor suggested in Sato. Claim 5 includes these limitations and includes further limitations which, in combination with the limitations of independent claim 1 are also neither disclosed nor suggested in Sato. It is asserted that this claim is patentable as well. Additionally, in rejecting claim 5, the Office Action states "Sato et al does not state which casing of the device is assembled first. However, this does not preclude Sato et al. selecting a first casing to be assembled." Office Action, page 4 (emphasis added).

The Office Action thus agrees that Sato does not show all of the limitations recited in claim 5. For a valid obviousness rejection, the cited prior art must show all of the claimed limitations. M.P.E.P. § 706.02(j). The mere fact that a cited reference is not "precluded" from showing a limitation does not mean that the reference actually discloses such a limitation.

With respect to claim 9, the Office Action summarily states " [t]he method of assembly is obvious in view of the apparatus rejected above. It is obvious that Sato et al. possesses a method of assembly for their apparatus and a rejection is appropriate in view of the apparatus rejection cited above." Applicant respectfully disagrees.

First, clearly because a structure is alleged to be shown in a prior art reference, it cannot be said that all corresponding methods are also shown in that reference. Second, the Office Action bases its rejection based on obviousness (35 U.S.C. §103) and so admits that the method is not shown in Sato. However, there is no indication what additional

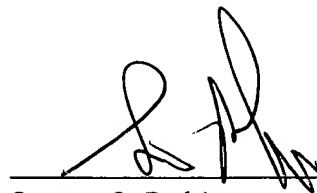
teaching is being added to Sato to produce the claimed invention; nor is there is a showing of the motivation for combining this extra teaching. M.P.E.P. §706.02(j). Third, as discussed more completely above, there is in indication that Sato shows an elastic member which supports a printed board as is claimed in independent claim 9.

Therefore, it is asserted that independent claim 9 is patentable over Sato. Claim 10 includes the limitations of claim 9 and includes further limitations which, in combination with the limitations of claim 9, are also neither disclosed nor suggested in the Sato. It is asserted that claim 9 is patentable as well. Reconsideration of the rejection of claims 5, 9 and 10 under 35 U.S.C. §103 is respectfully requested in light of the remarks above.

Applicant appreciates the provisional allowance of claim 7 and chooses to defer a rewriting of this claim until a final resolution of the above matters.

Respectfully submitted,

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Steven S. Rubin
Registration No.: 43,063
DICKSTEIN SHAPIRO MORIN & OSHINSKY, LLP
1177 Avenue of the Americas
New York, New York 10036
Telephone: (212) 835-1400

SIW/SSR/hc

APPENDIX A
Version With Markings To Show Changes Made
37 C.F.R. § 1.121(b)(1)(iii) AND (c)(1)(ii)

9. (Amended) A method of manufacturing a portable information radio terminal device [for assembling] including a first casing and a second casing, and for housing a printed board between said first and second casings, comprising:

[a step of] arranging said printed board on one of said first and second casings with an elastic member positioned between said printed board and said one of said first and second casings to support said printed board; and

[a step of] assembling the other of said first and casings to said one of said first and second casings while interpositioning said elastic member between said other of said first and second casings and said printed board.